



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,370	10/30/2001	Anthony David Peachman	072817.0141	9662

21003 7590 08/06/2003

BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER

ST CYR, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/021,370

Applicant(s)

PEACHMAN ET AL.

Examiner

Daniel St.Cyr

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 5/16/03.

#### *Claim Objections*

2. Claims 43 and 44 are objected to because of the following informalities: line 1, “, the improvement” should be deleted. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 6, 8, 9, 11, 12, 14, 16, 17, 19, 20, 22, 24, 25, 33, 39, 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuo et al, US Patent No. 5,754,762.

Kuo et al disclose secure multiple application IC card using interrupt instruction issued by operating system or application program to control operation flag that determines the operational mode of bi-modal CPU comprising: inherently including means for manufacturing the IC card; storing at the time of manufacturing in a read-only memory an operating system and programming instructions without an address table with memory address of at least one of said programming instructions, said programming instructions not being operational until subsequent storing of address table at the time of personalization, wherein the programming instructions inherently include codelets for switching from the system mode to the application mode ; and means for personalization said IC card after said manufacturing step and for storing in said

Art Unit: 2876

electrically erasable programmable read only memory said address table with memory address of at least one of said programming instructions and including storing additional programming instructions, wherein the operating system will only access the programming instruction in accordance with the address indicated in the address table (see col. 7, line 34 to col. 8, line 25).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2, 5, 7, 10, 13, 15, 18, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuo et al in view of Getzlaff et al, US Patent No. 5,870,601. The teachings of Kuo et al have been discussed above.

Kuo et al fail to disclose or fairly suggest that the instructions comprise primitive.

Art Unit: 2876

Getzlaff et al disclose that programming language utilized to program processors is commonly refer to assembler language wherein the assembler instructions comprise primitives. (see col. 1, line 10+).

In view of Getzlaff et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to employ the notoriously old and well known instruction format (i.e. primitive instruction) into the system of Kuo et al for processing the multiple application card. Such modification would simplify the instruction code so that the microprocessor could easily execute every instruction, which would make the system more effective. Therefore, it would have been an obvious extension as taught by Kuo et al.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of U.S. Patent No. 6,357,665. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somehow a broader recitation of the '665 Patent. For instance, in claim 1 of the instant application and the '665 Patent, the applicants claim:

i) "A secure multiple application card system including an IC card comprising a microprocessor, a read-only memory and an electrically erasable programmable read only memory, said system comprising:

means for manufacturing the IC card and for storing at the time of manufacturing in a read-only memory an operating system and programming instructions without an address table with memory address of at least one of said programming instructions, said programming instructions not being operational until subsequent storing of address table at the time of personalization; and

means for personalization said IC card after said manufacturing step and for storing in said electrically erasable programmable read only memory said address table with memory address of at least one of said programming instructions,

wherein the operating system will only access the programming instructions in accordance with the address indicated in the address table." Whereas in the '665 Patent, the applicants claim:

ii) "A secure multiple application card system including an IC card comprising a microprocessor, a read-only memory and an electrically erasable programmable read only memory, said system comprising:

means for manufacturing said IC card and for storing at the time of manufacture in said read-only memory an operating system and a first set of programming instructions having a first address, without an address table with a second memory address of a second set of programming instructions; and

means for personalizing said IC card after said time of manufacture and for storing at the time of personalization in said electrically erasable programmable read only memory said address table with the second memory address, wherein the operating system is incapable of accessing any set of programming instructions not having an address indicated in the address table, and wherein the address table is devoid of the first address such that the first set of programming instructions is rendered inaccessible after the time of personalization”.

As to the claims 1-44 of the instant application, the ‘665 Patent meets all the limitations as set forth in claims 1-48.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims ‘665 Patent as a general teaching for configuration of IC cards, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the ‘665 P patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of ‘665 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. IN re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the

Art Unit: 2876

conflicting application or patent is shown to be commonly owned with this application. See 37 C>FR> &1.78(d).

*Response to Arguments*

10. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.

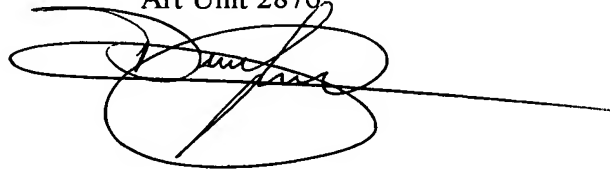
*Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over the printed name and title. The signature is stylized with loops and a long horizontal stroke extending to the right.

DS  
July 24, 2003